

## **REMARKS**

### **I. Status of the Claims**

Claims 1, 2, 5, 6, 13, 14, 17, 21-25, 27, 30-32, 34, 35, 49-51, and 53 are pending in this application. Claims 1, 2, 5, 6, 13, 14, 17, 21-25, 27, 30-32, 34, 35, and 49-51 stand rejected, while claim 53 is new. Claims 3, 4, 7-12, 15, 16, 18-20, 26, 28, 29, 33, 36-48, and 52 are canceled. Applicants reserve the right to pursue this subject matter in an application claiming priority to the present application.

New claim 53 recites the elected species of Example 157, (E)-3-(3,3-Dimethyl-2-oxo-2,3,4,5-tetrahydro-1H-pyrido[2,3-e][1,4]diazepin-7-yl)-N-methyl-N-(3-methyl-benzofuran-2-ylmethyl)acrylamide. No new matter has been added by this amendment.

Amendment of the originally filed claims, or cancellation of any claims should in no way be construed as an acquiescence, narrowing, or surrender of any subject matter. The amendments are being made not only to point out with particularity and to claim the present invention, but also to expedite prosecution of the present application. Applicants reserve the option to prosecute the originally filed claims further, or similar ones, in the instant or subsequently filed patent applications.

### **II. Priority Claim**

The Office has recognized Applicants' claim for the benefit of priority to U.S. Serial No. 60/465,583, filed April 25, 2003 ("the '583 application"). *Office Action* at p. 2. However, the Office contends that a priority claim to U.S. Serial No. 60/431,406, filed December 6, 2002, ("the '406 application") cannot be recognized as the '406 application allegedly does not comply with the enablement requirement of 35 U.S.C. § 112, first paragraph. *Id.* According to the Office, the '406 application does not support the elected Group I claims because variable R<sub>3</sub> on Formula I cannot be a pyrido[2,3-e]-1,4-diazepine ring. *Id.*

Applicants acknowledge that the elected subject matter is entitled to a priority date of April 25, 2003. By the response filed on September 9, 2008, claim 1 was amended to recite elected subject matter that is fully supported by the disclosure of the '583 application, filed April

25, 2003. For example, each claimed species for variable  $R_2$  in Formula I finds support at p. 32 of the '583 application.

### III. Rejection under 35 U.S.C. § 102

In the Advisory Action dated September 26, 2008, the Office maintained the rejection of claims 1, 2, 5, 6, 13, 14, 17, 21-25, 27, 30-32, 34, 35, and 49-51 under 35 U.S.C. § 102(c) as being anticipated by U.S. Patent Publication No. 2006/0142265 ("Berman"). *Id.* at p. 3. The disclosure in Berman relied upon by the Office as the basis for the 102(c) rejection must satisfy the requirements of 35 U.S.C. § 112, first paragraph. M.P.E.P. § 706.02(f)(1). Berman's earliest effective filing date is March 17, 2003, based on U.S. Serial No. 60/455,189 ("the '189 application"). Berman also claims priority to two provisional applications with filing dates after April 25, 2003, and these documents can not form the basis of a § 102(c) rejection based on that date.

For Berman to be effective prior art against the rejected claims, the disclosure relied upon in Berman must find the requisite support in the first Berman priority document (the '189 application).

The '189 application does not disclose any compound falling within the scope of currently pending claim 1. Rather, the '189 application discloses a compound of formula I wherein variable  $R_3$  (analogous to  $R_2$  in the present application) may be selected from 12 species. However, none of these species correspond to the  $R_2$  species of currently pending claim 1. Thus, support for Berman's alleged disclosure of anticipatory subject matter does not exist as of the March 17, 2003, filing date of the '189 application. Therefore, Berman does not anticipate the present claims.

### IV. Conclusion

Applicants respectfully request that in conjunction with the concurrently filed Request for Continued Examination, this Response under 37 C.F.R. § 1.111 be entered by the Examiner, placing claims 1, 2, 5, 6, 13, 14, 17, 21-25, 27, 30-32, 34, 35, 49-51, and 53 in condition for allowance.

In view of the foregoing remarks, Applicants submit that this claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art cited against this application. Applicants therefore request the entry of this Response, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Any questions raised by this submission may be directed to the undersigned at (617) 570-3914. In accordance with 37 C.F.R. § 1.136(a), please grant any extension of time that this paper requires but no accompanying paper requests. The Commissioner is hereby authorized to charge any underpayments, or credit any overpayments, to our Deposit Account No. 07-1700, **Reference: IPT-075.**

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Respectfully submitted,

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